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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

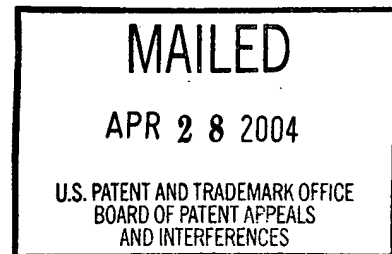
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT T. BELL,
PAUL S. HAHN, MICHAEL H. McCLUNG,
and RICHARD B. PLATT

Appeal No. 2002-1786
Application 09/032,083¹

ON BRIEF



Before BARRETT, RUGGIERO, and SAADAT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-12, 14-32, and 34-105.

We affirm.

¹ Application for patent filed February 27, 1998, entitled "System and Method for Performing Signaling on Behalf of a Stateless Client."

BACKGROUND

The invention relates to system and method for performing state-based signaling on behalf of a stateless client.

Claim 1 is reproduced below.

1. A system capable of performing state-based signaling on behalf of a stateless client, comprising:

a controller, couplable to a state-based terminal, that translates at least one stateless signaling message received from said stateless client to at least one state-based signaling message for presentation to said state-based terminal thereby facilitating a media stream communications session between said stateless client and said state-based terminal using an Internet Protocol (IP)-based network, wherein the media stream communications session is comprised of packets exchanged between said stateless client and said state-based terminal.

The examiner relies on the following references:

Iwami et al. (Iwami)	5,604,737	February 18, 1997
Bruno et al. (Bruno)	5,724,355	March 3, 1998
		(filed October 24, 1995)
Kubler et al. (Kubler)	5,726,984	March 10, 1998
		(filed October 5, 1995)
Arango	5,732,078	March 24, 1998
		(filed January 16, 1996)
Kikinis	6,201,804	March 13, 2001
		(effective filing date February 17, 1998)

Claims 1-12, 14-32, 34-90, 94, and 95 stand rejected under 35 U.S.C. § 112, first paragraph, for lack of written description.

Claims 91, 93, 98, 99, 101, 102, 104, and 105 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kikinis.

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Claims 1-6, 9, 11, 12, 14-26, 29, 31, 32, 34-47, 50-62, 65-73, 75-78, and 80-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubler and Kikinis.

Claims 41-46, 50-54, 56-61, 65-69, 71-73, 75-78, and 80-90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwami and Kikinis.

Claims 10 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubler and Kikinis, further in view of Bruno.

Claims 74 and 79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubler and Kikinis.

Claims 7, 8, 27, 28, 48, 49, 63, and 64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubler and Kikinis, further in view of Arango.

Claims 1-6, 9, 11, 12, 14-26, 29, 31, 32, 34-40, 47, 55, 62, and 70 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwami and Kikinis.

Claims 92, 94-97, 100, and 103 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kikinis.

Claims 96, 97, and 103 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kikinis, further in view of Bruno.

We refer to the final rejection (Paper No. 10) and the examiner's answer (Paper No. 18) (pages referred to as "EA__")

for a statement of the examiner's rejection, and to the appeal brief (Paper No. 16) and the reply brief (Paper No. 19) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

Written description

The examiner finds a lack of written description for the limitation, "the media stream communication session is comprised of packets exchanged between said stateless client and said state-based client," in claims 1-12, 14-32, and 34-80, and the limitation, "receiving, from a stateless client, a first packet comprising a stateless signaling message," in claims 81-90.

Appellants refer to the summary of the invention, which describes "a media stream communications session between the stateless client and the state-based terminal over an Internet Protocol (IP)-based network" (specification, p. 5). Appellants refer to Fig. 2, which describes a network 200 with "an external packet switched data network [e.g., Internet Protocol (IP)] 210, an IP gateway 215, a local network (e.g., IP Intranet) 220, a state-based terminal 225, ... second and third stateless clients 235, 236, 237" (specification, p. 13). The specification also describes that "[t]he network 200 network may employ a transport protocol selected from the group consisting of an Internet Protocol (IP), and Internetwork Packet Exchange/Sequence Packet

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Exchange (IPX/SPX) and a Systems Network Architecture (SNA) or any other transport protocol that is applicable to any non-circuit switched-mode network" (specification, p. 16).

The examiner finds that these disclosures do not support the limitations (EA13-15).

In order to satisfy the written description requirement, the disclosure as originally filed does not have to provide in haec verba support for the claimed subject matter at issue. See Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000). Appellants' Fig. 2 clearly discloses communication between state-based terminals 205, 206, 225 and stateless clients 235, 236, 237 over networks 210 and 220, which are disclosed to be Internet Protocol (IP), Internetwork Packet Exchange/Sequence Packet Exchange (IPX/SPX), or Systems Network Architecture (SNA) networks. It is well known in the art that higher-level protocols, such as TCP/IP, IPX/SPX, and SNA, are packet based and are designed to ride over packet-switched topologies. Since "Internetwork Packet Exchange/Sequence Packet Exchange (IPX/SPX)" even has the word "packet" in its title, it is not known why the examiner has persisted in the rejection. We find adequate written description support for the limitations at issue. Accordingly, the rejection of claims 1-12, 14-32, 34-90, 94, and 95 is reversed.

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Inadequacy of the 37 CFR § 1.131 declaration

After the final rejection, Robert T. Bell, one of the co-inventors, submitted a Declaration Under 37 C.F.R. § 1.131 (Paper No. 11, filed August 22, 2001) to swear behind the Kikinis patent, which has an effective filing date of February 17, 1998, (the "Effective Date") ten days before the filing date of the present application. The declaration was accompanied by a response after final rejection (Paper No. 12). The examiner entered an advisory action (Paper No. 13) on September 10, 2001, stating that the request for reconsideration had been considered, but that the written description rejection based on "packets" was not overcome; the examiner did not mention the Bell declaration. Appellants filed an extension of time and notice of appeal (Paper No. 14) on September 20, 2001. The examiner entered an advisory action (Paper No. 15) on October 9, 2001, stating that the paper of September 20, 2001, did not put the application in condition for allowance; again, the examiner did not mention the Bell declaration. Therefore, the examiner's answer is the first time the examiner addresses the insufficiency of the declaration.

The examiner states that a general allegation that the invention was completed prior to the date of the reference is not sufficient and that the declaration must state facts and produce documentary evidence in support thereof (EA16). The examiner finds that the declaration does not show facts supporting any of

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the three situations in § 1.131(b) (EA16). The examiner states that the evidence of the assignment was executed after the filing date of Kikinis and, thus, the declaration is ineffective (EA16).

We agree with the examiner that the Bell declaration is not factually sufficient to swear in back of the Kikinis patent.

37 CFR § 1.131(b) (2002) states:

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration o[r] their absence satisfactorily explained.

Since no actual reduction to practice is alleged, the only situation that fits this case is "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date ... to the filing of the application." Rule 131 requires documentary evidence to show facts: "Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration o[r] their absence satisfactorily explained" (emphasis added). Mere allegations (statements declaring something to be true, without its having yet been proved), even though in an affidavit or declaration, are not sufficient.²

² Statements in the Bell declaration are equivalent to oral testimony by an inventor. Although the issue is more common in interference and infringement proceedings, it could be said that

The Bell declaration states (§ 3):

Prior to the effective date, my co-inventors and I developed a complete understanding and appreciation of the subject matter of the above-referenced invention. With the help of a patent attorney, we generated a draft of the Application that, prior to the Effective Date, was substantially identical to and included all of the subject matter of the Application as filed.

Appellants argue that this "fact" demonstrates, at least, a conception of the invention prior to the effective date (RBr3). It is argued that since the application as filed was already a part of the record, resubmitting a copy with the declaration would do little more than bloat the file (RBr4).

No copy of the specification and drawings submitted to the attorney prior to the Effective Date has been provided, nor its absence explained. Bell's statement that the draft application included all of the subject matter of the application as filed is not supported by evidence. The specification and drawings submitted with the application are evidently not the specification and drawings that were submitted to the attorney and, therefore, are not evidence supporting Bell's allegation of conception. Resubmitting a copy of the specification and

corroboration is required to support an inventor's testimony regarding his conception and diligence in pursuit of the invention. See, e.g., In re Jolley, 308 F.3d 1317, 1324, 64 USPQ2d 1901, 1906 (Fed. Cir. 2002) ("Jolley is correct, of course, that inventor testimony regarding conception must be corroborated."). Nevertheless, it is not necessary to decide whether corroboration is required under § 1.131 since appellants have not established conception or due diligence.

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drawings, as filed, would be pointless. Therefore, we find no evidence of conception. However, we continue to address the due diligence aspect of the § 1.131 declaration.

The Bell declaration states (§ 4):

Between the Effective Date and our filing date on February 27, 1998, a period of ten days, we finalized the paperwork in anticipation of filing. Exhibit A is an Assignment transferring the rights to this invention from each of the inventors. This assignment, executed on February 25, 1998, demonstrates some of our continuing activities, which began prior to the Effective Date and continued through to the filing date of the Application at issue.

Based on this, appellants argue (RBr3):

Thus the facts show diligence for the brief period that began prior to the Effective Date and lasted through the filing of the Application (this period is less than two weeks, from February 17 to February 27 of 1998). The Declaration therefore satisfies at least [that condition of 37 CFR § 1.131(b)] which requires conception of the invention prior to the Effective Date coupled with due diligence from prior to the Effective Date to the filing date of the Application.

Bell's statements are not sufficient to prove due diligence from prior to the Effective Date to the filing date of the application. Although there is only a ten-day gap between the Effective Date of February 17, 1998, and the filing date of February 27, 1998, the shortness of the time period does not excuse a showing of due diligence. The requirement of § 1.131(b) for a factual showing of due diligence is reasonable because appellants seek to remove a reference that would otherwise be prior art. There is no showing of due diligence between the

Effective Date and February 25, 1998, when the assignments were executed, except for the unsupported statement that "Between the Effective date and our filing date on February 27, 1998, a period of ten days, we finalized the paperwork in anticipation of filing" (Bell declaration, ¶ 4). No description or evidence what was being done during this time has been provided, such as attorney billing records, telephone conferences, etc. If all of the papers were turned over by the inventors to the attorney for preparation for filing before the Effective Date, it seems unlikely that Bell would have enough knowledge of the activities that show due diligence. While the assignment is evidence of diligence, it does not explain the period between the Effective Date and the assignment, nor the period from the assignment to the filing date, i.e., the story of what happened during these periods is missing along with the documentation. We will not guess that appellants were being diligent during these periods, even though the time periods are small. Due diligence does not allow for unexplained gaps. Therefore, we conclude that the Bell declaration is not sufficient to antedate the Kikinis patent.

Anticipation and obviousness

All of the anticipation and obviousness rejections rely on Kikinis, alone or in combination. Appellants argue that the rejections must be reversed because Kikinis may not be used to support any of the rejections. If Kikinis had been antedated by

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the § 1.131 declaration, all rejections would have been overcome. However, Kikinis has not been overcome and appellants have not argued the merits of the rejections. Accordingly, the rejections of claims 1-12, 14-32, and 34-105 under 35 U.S.C. §§ 102 and 103(a) are sustained.

CONCLUSION

The rejection of claims 1-12, 14-32, 34-90, 94, and 95 under 35 U.S.C. § 112, first paragraph, is reversed.

The rejections of claims 1-12, 14-32, and 34-105 under 35 U.S.C. §§ 102 and 103(a) are sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Lee E. Barnett

LEE E. BARRETT
Administrative Patent Judge

JOSEPH F. RUGGIERO

JOSEPH F. RUGGIERO
Administrative Patent Judge

Marshall D. Sadat

MAHSHID D. SAADAT
Administrative Patent Judge

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